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Kazuhisa Mukai

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

BARNHART, LORA ELIZABETH

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Continuation Sheet for Advisory Action

Continuation of Box 3. The proposed amendments will not be entered because they introduce new claim elements that have not heretofore been considered, specifically the sequence ID numbers at the end of claim 1. Had this limitation been included in the original claims, the examiner would have properly required an election of species since these sequences do not appear to share function and a common core structure. Furthermore, the amendments to the claims appear to incorporate the limitations of claims 3 and 4 into claim 1, but claims 3 and 4 have not been cancelled, thus introducing issues of indefiniteness. For at least these reasons, the claims are not entered at this time.

Continuation of Box 11. The request for reconsideration has been fully considered, but it does NOT place the application in condition for allowance because it would not overcome all of the rejections of record even if the proposed amendments were entered.

Regarding the indefiniteness rejection, the examiner has not argued “substantially” is per se indefinite, but the claim does not particularly set forth what degree of increase would be considered “substantial.” As such, the metes and bounds of the claim cannot be determined, because it is not clear which conditions would be encompassed by the claim and which would not. Furthermore, the amendments to the claims introduce new issues under 35 U.S.C. § 112, second paragraph, as discussed above.

Art Unit: 1651

Regarding the art rejection, even if the enzyme of Yamamoto is distinct from those referenced in the proposed amendment to claim 1 (which the examiner does not concede), a prior art search for the claimed enzymes may necessitate a section 103 rejection, which has not been addressed herein. Further consideration is required.